

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

NOV 13 2003

Ex parte LAWRENCE N. TAUGHER

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2002-1235
Application No. 08/823,823

ON BRIEF

Before KIMLIN, WARREN and WALTZ, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-11.

Claim 1 is illustrative:

1. An apparatus for write protection of a disk, the disk having a power calibration area and a data area, the apparatus comprising:

a ring capable of being attached to the disk, the ring having a portion that covers the power calibration area but not the data area.

Appeal No. 2002-1235
Application No. 08/823,823

In addition to the admitted prior art, the examiner relies upon the following references as evidence of obviousness:

Takahashi et al. (Takahashi) 04-095287 Mar. 27, 1992
(Japanese Published Unexamined Patent)

Dana J. Parker et al. (Parker), CD-ROM Professional's CD-Recordable Handbook - The Complete Guide to Practical Desktop CD 82-85 (David R. Guenetta ed., 1996)

Appellant's claimed invention is directed to an apparatus and method of providing write protection of a recordable disk by covering or altering the power calibration area of the disk. According to appellant's specification, before writing or recording information on a disk, the disk drive must calibrate laser power by writing into the power calibration area. If the drive cannot read its calibration pattern in the calibration area on the disk, "it will not erase or write in the data area of the disk" (page 2 of specification, second paragraph). In the present case, appellant covers or abrades the power calibration area to prevent writing data on the recordable area of the disk.

Appealed claims 1-4 stand rejected under 35 U.S.C. § 112, second paragraph. Appealed claims 1-11 stand rejected under 35 U.S.C. § 103 as being unpatentable over the admitted prior art in view of Parker and Takahashi.

Appeal No. 2002-1235
Application No. 08/823,823

Appellant presents separate arguments for claims 1, 4, 5, 6 and 7, whereas claims 2, 3 and 8-11 stand or fall together with the claims upon which they depend.

We have thoroughly reviewed the respective positions advanced by appellant and the examiner. In so doing, we concur with appellant that the examiner's rejections are not well-founded. Accordingly, we will not sustain the examiner's § 112 and § 103 rejections.

Concerning the examiner's rejection of claims 1-4 under § 112, second paragraph, it is the examiner's position "the phrase 'capable of' renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention" (page 3 of Answer, last sentence). However, we agree with appellant that the claim language is an appropriate use of functional language which requires that the recited ring be capable of being attached to the disk such that it covers the power calibration area but not the data area. The examiner has not met the initial burden of explaining why, prima facie, one of ordinary skill in the art would not be reasonably apprised of the scope of claims 1-4.

We now turn to the examiner's § 103 rejection of all the appealed claims. The examiner correctly states that it is part

of the admitted prior art that a recordable disk has a power calibration area that must be read by a laser before recording is accomplished. The examiner then concludes that "[t]o cover any area of any subject in order to prevent an operation to take place in such an area is a common practice and is nothing new in the art" (page 4 of Answer, third paragraph). The examiner further cites Figure 1 of Takahashi for its depiction of a recording inhibition seal.

The flaw in the examiner's reasoning is that it does not rely upon a prior art disclosure which discloses covering a functional area of a disk, let alone the presently claimed power calibration area. As explained by appellant, Example 1 of Takahashi utilizes an inhibition seal which presents a logical choice for not recording but does not physically interfere with the functional area of the recording medium. Accordingly, the examiner's conclusion of obviousness is without the requisite factual support. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967), cert. denied 389 U.S. 1057 (1968). In addition, the examiner has failed to articulate the rejection of separately argued claims 4-7, or respond to appellant's arguments for these claims. Such a failure constitutes reversible error.

While we agree with appellant that the examiner has not established a prima facie case of obviousness for the appealed claims, we do not agree with appellant that "[t]he examiner has not cited any prior art that teaches or suggests covering a functional area of a medium" (page 1 of Reply Brief, second paragraph). Example 2 of Takahashi expressly discloses "a recording inhibition sheet member which is removably attached to at least cover the recording area of the optical disk memory body for blocking the recording light, allowing only the reproduction light to pass through the sheet" (page 4 of translation, third paragraph). As stated at page 5 of the translation, "this invention provides a method that removably adheres a recording inhibition sheet having a filtering function for specific optical frequencies (recording frequency) at least in the area of the recording region to inhibit the data overwriting" (first paragraph). The exemplification of this process can be found at page 10 et seq. of the translation. Accordingly, based on this section of the Takahashi disclosure which has not been relied upon by the examiner nor addressed by appellant, this application is remanded to the examiner to determine the obviousness of covering the power calibration area of a disk in the same manner the recording area of the disk is covered in Takahashi. Since it

Appeal No. 2002-1235
Application No. 08/823,823

was admittedly known in the art that the power calibration area of the disk is necessarily readable in order to effect recording, it may well have been a matter of obviousness, based upon the admitted prior art and Takahashi, to cover a functional area of the disk other than the recording area, namely, the presently claimed power calibration area. As for appellant's use of an abrasive tool to abrade the power calibration area to render the disk permanently non-recordable, the examiner should determine the obviousness of destroying a feature of the disk that is necessary for recording when recording is not desired. Likewise, the examiner should determine the obviousness of the appealed claims separately argued by appellant.

In conclusion, based on the foregoing, the examiner's rejections under 35 U.S.C. § 112 and 35 U.S.C. § 103 are reversed. This application is remanded to the examiner for the reasons set forth above.

Appeal No. 2002-1235
Application No. 08/823,823

This application, by virtue of its "special" status,
requires immediate action by the examiner. See the Manual of
Patent Examining Procedure, § 708.01(D) (8th ed., Aug. 2001).

REVERSED AND REMANDED

Edward Kimlin
EDWARD C. KIMLIN)
Administrative Patent Judge)
)
Charles F. Warren
CHARLES F. WARREN) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
)
Thomas A. Waltz
THOMAS A. WALTZ)
Administrative Patent Judge)

ECK:clm

Appeal No. 2002-1235
Application No. 08/823,823

Hewlett Packard Co.
P.O. Box 272400, 3404 E. Harmony Road
Intellectual Property Administration
Fort Collins, CO 80527-2400